

REMARKS

Claims 1-36 were originally presented in the subject application. Claims 1, 13 and 25 were amended in an Amendment and Response to Office Action dated June 4, 2004. Claims 37-48 were added in an Amendment and Response to Final Office Action dated November 5, 2004. Claims 1, 13, 25 and 37 have herein been amended. No claims have herein been added or canceled. Therefore, claims 1-48 remain in this case.

The addition of new matter has been scrupulously avoided with the amendments herein. In that regard, support for the common amendment to the independent claims can be found in the specification at, for example, page 3, lines 23-24.

Applicants respectfully request reconsideration and withdrawal of the grounds of rejection.

Drawings

The Office Action required that FIG. 1 be amended to indicate it as prior art. In response, Applicants include herewith a new FIG. 1 amended as required. As amended, Applicants submit FIG. 1 is in proper form.

Double Patenting

Claims 1-48 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting, as allegedly unpatentable over claims 1-45 of co-pending U.S. Patent Application Serial No. 09/751,078 (US 2002/0087477 A1). Applicants respectfully, but most strenuously, traverse this rejection.

The Office Action alleges the difference between the present application and the cited application is “nonfunctional descriptive material.” See the Office Action at page 3. In support of this allegation, the Office Action cites to case law, specifically, *In re Gulack* and *In re Lowry*. *In re Gulack*, the first cited case, is a printed matter case, and, therefore, not applicable to the present application. More surprising, however, is the citation to *In re Lowry*, which came after *In re Gulack*, and specifically stands for the proposition that printed matter case law is

inapplicable to computer-based inventions, overturning a rejection of a data structure claim that had been upheld by the Board on printed matter grounds. Thus, within the case law itself cited in the final Office Action is the clear direction that printed matter rejections are not to be used in cases such as the present application. “Printed matter” in the Office Action is disguised in the form of “nonfunctional descriptive material” allegations.

Therefore, Applicants submit that the basis for the rejection is improper and respectfully request that the double patenting rejection be withdrawn.

35 U.S.C. §112 Rejection

The Office Action rejected claims 1-48 under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter not adequately described in the application. Applicants respectfully, but most strenuously, traverse this rejection.

Specifically, the Office Action alleged that the limitation “preexisting entitlement” in the independent claims lacks proper written description support in the specification.

On page 2 of the application, at lines 12-16, the definition of “entitled price” is given as:

Such negotiated prices are referred to herein as the “entitled price,” which is the price a buyer is entitled to for a given item based on an entitlement, such as, for example, a contract with the seller or a promotional offer from the seller (e.g., a coupon) or a program with a business partner of the seller (e.g., “point” programs similar to airline mileage programs).

In addition, page 8, lines 21-23 provides a further example.

Therefore, Applicants submit that “preexisting entitlement” does not lack description or support in the specification.

35 U.S.C. §103 Rejection

The Office Action rejected claims 1-3, 9-11, 13-15, 21-23, 25-27, 33-35, 37-39 and 45-47 under 35 U.S.C. §103, as allegedly obvious over Lidow (U.S. Patent No. 6,889,197). Applicants respectfully, but most strenuously, traverse this rejection.

As an initial matter, Applicants expressly reserve the right to challenge the proper citation of Lidow against the present application, because it is unclear whether the Lidow claim back to U.S. Provisional Application Serial No. 60/175,868 is even proper. This priority claim appears to be the only basis upon which Lidow could be cited, since it is the only date in the chain that predates the filing date of the present application.

Amended claim 1 recites a method of providing an entitled price in an electronic transaction. The method comprises electronically sending by a requestor a request for an entitled price based on a preexisting entitlement from a public electronic environment, automatically routing the request to a private electronic environment, obtaining the entitled price within the private electronic environment in real time while the requestor waits, and automatically returning the entitled price from the private electronic environment to the public electronic environment for providing to the requestor.

The Office Action admits that “Lidow does not teach that the information requested is an entitled price.” See the Office Action at page 5. Nonetheless, the Office Action alleges that the entitled price is “nonfunctional descriptive material,” again citing *In re Gulack* and *In re Lowry*.

In light of the remarks above regarding this case law, Applicants submit that the limitations in claim 1 involving the claimed entitled price cannot be ignored. Thus, it becomes clear that the claimed electronically sending is not taught or suggested by Lidow, nor are any of the other limitations, as they all center on the claimed entitled price.

Moreover, Applicants have amended claim 1 to make clear that the entitled price is obtained in the private electronic environment in real time while the requestor waits. This is what the original language “while the requestor waits” was intended to mean. Thus, Applicants are merely clarifying what was already impliedly present. In that sense, Applicants do not view the amendment as further limiting the claims.

In any case, providing a price to the buyer in Lidow, in the form of a bill, only happens after shipment of the goods ordered. Lidow apparently assumes that since the price is based on a contract, the parties concerned already know the price. See, e.g., Lidow at column 23, part VI.

Billing and Payment. Thus, billing (and hence, providing any price) is not contemporaneous with the original request, and is not obtained in real time while the requestor waits for it.

Therefore, Applicants submit that claim 1 cannot be rendered obvious over Lidow.

Claims 13, 25 an 37 contain limitations similar to those noted above with respect to claim 1. Thus, Applicants submit the remarks made above regarding claim 1 are equally applicable to those claims. Therefore, Applicants submit none of claims 13, 25 or 37 can be made obvious over Lidow.

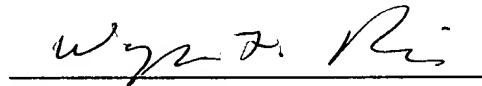
CONCLUSION

Applicants submit that the dependent claims not specifically addressed herein are allowable for the same reasons as the independent claims from which they directly or ultimately depend, as well as for their additional limitations.

For all the above reasons, Applicants maintain that the claims of the subject application define patentable subject matter and earnestly request allowance of claims 1-48.

If a telephone conference would be of assistance in advancing prosecution of the subject application, Applicants' undersigned attorney invites the Examiner to telephone him at the number provided.

Respectfully submitted,

  
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